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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/528,057	03/15/2005	Francesco Arduini	23237	9026
535 7590 11/06/2008 K.F. ROSS P.C. 5683 RIVERDALE AVENUE SUITE 203 BOX 900 BRONX, NY 10471-0900				
EXAMINER KIM, WESLEY LEO				
ART UNIT		PAPER NUMBER		
2617				
MAIL DATE		DELIVERY MODE		
11/06/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/528,057

**Applicant(s)**

ARDUINI ET AL.

**Examiner**

WESLEY L. KIM

**Art Unit**

2617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 10 July 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 July 2008 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/CDC)
- Paper No(s)/Mail Date \_\_\_\_\_

- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Amendment***

1. This Office Action is in response to Amendment filed on 7/10/08.
  - Claims 2 and 16 are cancelled.
  - Claims 1, 3-15, and 17-29 are currently amended.
  - Claims 1, 3,15, and 17-29 are pending in the current Office Action.
  - The examiner has added in a new grounds of rejection, the 35 U.S.C. 101 rejection, so therefore this Office Action is made Non-Final.

### ***Response to Arguments***

Applicant's arguments filed 7/8/08 have been fully considered but they are not persuasive.

- Applicant argues that the combination of Hyvarinen and Fenton is inappropriate.

The examiner respectfully disagrees. Hyvarinen teaches that a service is provided by a first system and if it cannot provide service then a second system is used to see if service can be provided (Abstract) and Fenton teaches that certain features of a wireless network are known to operate in certain networks while not in others. For example, SMS and voice services (i.e. second set) which will work in 2G and 3G networks while MMS services (i.e. first set) will only work in 3G networks (Par.2). By combining Hyvarinens' teachings in combination with Fentons' it is obvious that when an service (SMS) cannot be provide within a first network (i.e. 3G network) due to lack of resources, then a second network (i.e. 2G network) could be used provide the service. This way, a requested service may be provided to the user

making the request so that the user is satisfied with the performance of the service provider. As can be seen, the combination is appropriate.

- Applicant argues that Hyvarinen nor Fenton alone or in combination teaches a step of subdividing the telecommunications services into a first and second set and on the basis of this subdivision verifying the possibility allocating the requested telecommunication services on the appropriate system so as to improve the management of the radio resources required to deliver the telecommunications services.

The examiner respectfully disagrees. Based on the examiners broadest reasonable interpretation of the claims, the limitation as recited above is addressed. See the rejection of claims 1 and 14 as can be seen below and further to the portion of "To a skilled artisan, it is obvious that Fentons' teaching reads on the limitation of subdividing the telecommunications services into a first set of services to be substantially provided through said second system, and a second set of services to be provided through both said first system and said second system. The system obviously subdivides the available services into categories of a first and second set, where the SMS service falls under the second set capable of being provided through the first and second system and the MMS service falls under the first set which is only capable of being provided through the second communication system."

***Drawings***

As recited in the previous Non-Final Office Action (1/9/08), New corrected drawings in compliance with 37 CFR 1.121(d) are required in this application because the drawings are of poor quality and labeled by hand. Applicant is advised to employ the services of a competent patent draftsman outside the Office, as the U.S. Patent and Trademark Office no longer prepares new drawings. The corrected drawings are required in reply to the Office action to avoid abandonment of the application. The requirement for corrected drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 29 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claim 29 is directed to a computer program product and from Paragraph 6 of the specification, it is clear that a computer program product is a program, *per se*, that may or may not be loaded into memory. From the 2106.01 of the MPEP, a program, per se, is non-statutory.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 1, 8-9, 14-15, 23-24, and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hyvarinen et al (US 2002/0085540 A1) in view of Fenton et al (US 2003/0126263 A1).

**Regarding Claims 1, 14, and 29,** Hyvarinen teaches method for the provision of telecommunications services in an environment in which there are a plurality of systems working according to different standards and reachable from a terminal in an integrated way (Par.6 and Fig.2), wherein at least one of said services can be provided by several systems of said plurality (Par.6, a service requested by user can be provided by either system), said method being characterized in that it incorporates a module (Par.20: LDB) capable, when there is a request of provision of said at least one service, of cooperating with said plurality of telecommunications systems (Par.20) : verifying the availability for the provision of the requested service of at least a first and a second system of said plurality (Par.6), the first system forming with regard to said second system, a resource to be exploited in a preferential way (Par.33-34 and Par.6, resource exploited to provide desired service if the system is available) and selecting, in an automatic and dynamic way, at least one between said first and said second system of the plurality for the provision of the requested telecommunication service (Par.6, upon user request, connection between first or second network occurs automatically and dynamically based on whether or not the service can be provided) and Hyvarinen further teaches selecting, among said plurality of systems, at least said first and a second system (Abstract and Fig.1), in the cases of a provision request for a service of said second set

(Abstract, i.e. provision request for data service, where data service is of second set), verifying the availability of said first system in order to provide said service of said second set (Par.6), as requested and providing said service of said second set as requested, through said first system if said first system is available (Par.6 and Par.33-34), if said first system is unavailable, for the transmission of a said service of said second set as requested, verifying the availability of said second system to provide said service of said second set, as requested (Par.6 and Par.33-34, if first system not available then uses second system), and providing and not providing said service of said second et, as requested, depending on whether or not said second system is available for the provision of said service of said second set, as requested (Par.6 and Par.33-34, service may or may not be provided based on whether or not the network has enough resources). From Hyvarinen it is obvious that the teaching of utilizing another system in case a first system is not capable of handling the requested service could be applicable to not only the specific systems as taught in Hyvarinen but to other various systems (Par.55); however Hyvarinen is **silent on** subdividing the telecommunication services into a first set of telecommunication services to the substantially provided through the second telecommunication system, and a second set of telecommunication services to be provided through the first telecommunication system and the second telecommunication system, in case of a request for provision of a telecommunication service from the first set, verifying the availability of the second telecommunication system for providing the telecommunication service of the first set as requested,

supplying and not supplying respectively the telecommunication service of the first set through the second telecommunication system, depending on whether or not the second telecommunication system is available.

Fenton teaches that certain features of a wireless network are known to operate in certain networks while not in others. For example, SMS and voice services (i.e. second set) which will work in 2G and 3G networks while MMS services (i.e. first set) will only work in 3G networks (Par.2). From Fentons' teaching in combination with Hyvarinens it is obvious that when an SMS service cannot be provide within a 3G network (i.e. first network) due to lack of resources, then a 2G network (i.e. second network) could be used provide the service. To a skilled artisan, it is obvious that Fentons' teaching reads on the limitation of subdividing the telecommunications services into a first set of services to be substantially provided through said second system, and a second set of services to be provided through both said fit system and said second system. The system obviously subdivides the available services into categories of a first and second set, where the SMS service falls under the second set capable of being provided through the first and second system and the MMS service falls under the first set which is only capable of being provided through the second communication system.

By the combination, it is clear in case of a request for provision of a telecommunication service from the first set (i.e. MMS), verifying the availability of the second telecommunication system for providing the telecommunication service of the first set as requested, supplying and not supplying respectively the



telecommunication service of the first set through the second telecommunication system, depending on whether or not the second telecommunication system is available (Since 3G is the only system capable of providing MMS, if resources are not available, then the service cannot be provided).

To one of ordinary skill in the art, it would have been obvious to modify Hyvarinen with Fenton such that the telecommunication services are subdivided into a first set of telecommunication services to be substantially provided through the second telecommunication system, and a second set of telecommunication services to be provided through the first telecommunication system and the second telecommunication system, and in case of a request for provision of a telecommunication service from the first set, verifying the availability of the second telecommunication system for providing the telecommunication service of the first set as requested, supplying and not supplying respectively the telecommunication service of the first set through the second telecommunication system, depending on whether or not the second telecommunication system is available, to provide a method where a requested service is correctly labeled as belonging to a certain set of services so that a user does not have to wait for long periods of time as the network wastes time in attempting to obtain service in a network where the service is not even available.

**Regarding Claim 8**, the combination of Hyvarinen and Fenton teaches that selecting is carried out by selecting the systems in the group formed by the mobile

communication systems (Fenton Par.2, 3G would be used for MMS and 2G for SMS).

**Regarding Claims 9 and 23**, Hyvarinen teaches it is obvious that the teaching of utilizing another system in case a first system is not capable of handling the requested service could be applicable to not only the specific systems as taught in Hyvarinen but to other various systems (Par.55 and Fig.1, selecting can obviously select from UMTS/ WLAN/802.11 systems).

**Regarding Claims 15 and 24**, Hyvarinen further teaches said module is integrated into a controller element common to said at least a first and second system of said plurality (Par.30, obviously in a controller of the network).

2. Claims 3-6 and 17-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hyvarinen et al (US 2002/0085540 A1) and Fenton et al (US 2003/0126263 A1) in further view of Kim (US 6044091).

**Regarding Claims 3-5 and 17-19**, Hyvarinen and Fenton teach all the limitations as recited in claims 2 and 14, respectively, and the combination further teaches verifying the unavailability of said second system for the provision of said service of said subset as requested (Hyvarinen Par.33-34), however the combination **is silent on** once said unavailability has been verified, the step of re-negotiating the provision request whereby said service of said subset is again requested for the provision in a condition of modified communication resources.

Kim teaches that it is well known in the art that when a service requested cannot be provided due to a lack of resources, a renegotiation will occur to obtain

the service at a lower quality of service (Col.5;23-28). To one of ordinary skill in the art, it is obvious that this teaching reads the limitation of once said unavailability has been verified, the step of re-negotiating the provision request whereby said service of said subset is again requested for the provision in a condition of modified communication resources.

To one of ordinary skill in the art, it would have been obvious to modify Hyvarinen and Fenton with Kim such that once said unavailability has been verified, the step of re-negotiating the provision request whereby said service of said subset is again requested for the provision in a condition of modified communication resources, to provide a method where service is provided to the end user even if it is at a quality slightly lower than desired.

**Regarding Claims 6 and 20**, Hyvarinen further teaches the first set includes services of conversational class (Par.22, voice communication is conversational class and voice is obviously available in both networks) and from the combination of Hyvarinen and Fenton it is obvious that the second set could include interactive services (Fenton, Par.2, i.e. MMS).

3. Claims 7 and 21-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hyvarinen et al (US 2002/0085540 A1), Fenton et al (US 2003/0126263 A1), and Kim (US 6044091) in further view of Shavit et al (US 2002/0160757 A1).

**Regarding Claims 7 and 21**, the combination of Hyvarinen, Fenton, and Kim teach all the limitations as recited in claims 6 and 18, however **the combination does not expressly teach** that the second set includes streaming class services.

Shavit teaches that it is well known in the art that a first set of services provided by 2G systems include voice and SMS which a second set of services provided by 3G systems includes streaming services (Par.24).

Therefore, to one of ordinary skill in the art, it would have been obvious to modify Hyvarinen, Fenton, and Kim with Shavit to provide streaming services only within the 3G systems so that users are provided with as many services as are available to them within the systems.

**Regarding Claim 22**, from Hyvarinen it is clear that the means are configured to co-operate with mobile communications systems including the telecommunications systems of the plurality (Abstract).

4. Claims 10-13 and 25-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hyvarinen et al (US 2002/0085540 A1) and Fenton et al (US 2003/0126263 A1) in further view of Duncan et al (US 7283550 B2).

**Regarding Claims 10, 12, 25, and 27**, Hyvarinen and Fenton teach all the limitations as recited in claim 1 and 14, however the combination **does not expressly teach** verifying the availability of the first/second telecommunication system on the basis of a criterion of admission control of the users by detecting the performance degradation of the first telecommunication system as the number of users increases.

Duncan teaches verifying the availability of a first/second telecommunication system on the basis of a criterion of admission control of the users by detecting the performance degradation of the first telecommunication system as the number of

users increases (Col.1:lines 27-34 and Col.6:lines 1-5, when there are insufficient resources, that means that a load threshold has been reached).

Therefore to one of ordinary skill in the art, it would have been obvious to modify Hyvarinen and Fenton with Duncan such that availability of a first telecommunication system is verified on the basis of a criterion of admission control of the users by detecting the performance degradation of the first telecommunication system as the number of users increases, to provide a method of determining whether or not resources can be efficiently and fairly distributed to the user requesting service provision based on the number of users and remaining resources.

**Regarding Claims 11, 13, 26, and 28**, Duncan further teaches detecting the total bit rate available to the active user on the first communication system and considering the first telecommunication system as unavailable for a new user when the bit rate available upon the possible determination of the new user reaches a threshold value (Col.1:27-34 and Col.5:line 62-Col.6:line 5, data rate is bit rate. Pole capacity is the amount of users utilizing resources).

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to WESLEY L. KIM whose telephone number is (571)272-7867. The examiner can normally be reached on Monday-Friday 9:00am-5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, George Eng can be reached on 571-272-7495. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/George Eng/  
Supervisory Patent Examiner, Art Unit 2617

/Wesley L Kim/  
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